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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

In re Application of:	:	
KIM, June, Man, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/560,664	:	37 CFR 1.47(b)
PCT No.: PCT/KR2004/001851	:	
International Filing Date: 23 July 2004	:	
Priority Date: 24 July 2003	:	
Attorney's Docket No.: 05-597-B	:	
For: SYSTEM AND METHOD FOR	:	
TRACKING POSITION OF A	:	
MOBILE UNIT USING BEACONS IN	:	
A MOBILE COMMUNICATION	:	
SYSTEM	:	

This decision is issued in response to the "Petition Under 37 CFR 1.47(b)" filed 19 October 2006. Petitioner has filed the required petition fee.

BACKGROUND

On 23 July 2004, applicants filed international application PCT/KR2004/001851. The application claimed a priority date of 24 July 2003, and it designated the United States. On 03 February 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 24 January 2006.

On 13 December 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 17 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497 was required.

On 19 October 2006, petitioner filed a response to the Notification Of Missing Requirements, with required four-month extension fee. The response included the petition under 37 CFR 1.47(b) considered herein, which seeks acceptance of the application without the signature of the inventors, whom petitioner states have refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present submission satisfies items (1), (3), (4), and (6).

Regarding item (1), petitioner has submitted the required \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the inventors have refused to execute the application papers, section 409.03(d) of the MPEP states that a "copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a declaration by Jiwon Lim, with accompanying exhibits, as evidence of the efforts to obtain the signatures of the non-signing inventors. The exhibits include copies (with English translations) of correspondence mailed to the non-signing inventors (the mailing directed to inventor PARK was returned because the address was not current), and email correspondence with inventor PARK; the statement of Jiwon Lim also refers to a firsthand discussion with inventor PARK in which inventor PARK stated that the inventors would not sign the declaration.

The materials provided here are not sufficient to demonstrate that the inventors have refused to execute the application. Petitioner has not provided a showing that a copy of the complete application papers (including the specification, claims, and drawings) has been mailed to the last known addresses of the inventors, as required before a refusal can be claimed (the present submission only states that the declaration and assignment documents were sent to the inventors; there is no reference to the a copy of the application itself).¹ In addition, inventor PARK'S statement of refusal cannot be accepted on behalf of the other inventor, inventor KIM. Confirmation that a request for signature, accompanied by a copy of the complete application, has been mailed to the last known address of both of the inventors, and that the inventors have refused to provide the required signed declaration, is required before it can be concluded that the inventors have refused to execute the application. Accordingly, on the present record, item (2) is not satisfied.

Regarding item (3), the petition includes an express statement of the last known addresses of the non-signing inventors. Item (3) is satisfied.

¹ It is noted that the copies of these mailings included with the present petition include Korean documents that appear to be application materials; however, these materials have not been translated and it is not clear exactly what these documents are. Without further clarification, it cannot be concluded that these documents represent a copy of the complete application, as required.

Regarding item (4), the petition includes a declaration executed on behalf of the non-signing inventors by a representative of the 37 CFR 1.47(b) applicant, UTStarcom Korea Limited ("UTStarcom Korea"). Item (4) is therefore satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts that it has the required proprietary interest based on a chain of assignments, first from the inventors to Hyundai Syscomm ("Hyundai"), then from Hyundai Syscomm to UTStarcom Korea. With respect to such a claim, the MPEP states the following:

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

The present petition includes copies of the assignments relied upon, and a statement under 37 CFR 3.73(b) has been submitted which properly references these assignments. However, additional evidence is required to confirm that the original assignment from the inventors to Hyundai relates to the subject matter of the present application. The assignment was executed prior to the filing of the priority application herein, and it therefore does not expressly refer to such application. Petitioner must provide a statement from a person with firsthand knowledge confirming that the invention referred to in the assignment from the inventors to Hyundai is the invention disclosed in the present application. In addition, the assignment from Hyundai to UTStarcom Korea refers only to the Korean priority document, not to the international application (which was not yet filed at the time of the assignment). Under such circumstances, a statement is required from a person with firsthand knowledge confirming that the invention disclosed in the international application is the same as that disclosed in the assigned priority application. Until the supplemental materials described above are provided, item (5) is not considered satisfied.

Regarding item (6), the petition includes the required statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2) and (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459